

REMARKS

The Final Office Action dated January 21, 2005 contained a final rejection of claims 1-20. The Applicant has amended independent claims 1, 6, 9, 14 and 17. Claims 1-20 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

Record is made of a telephonic interview between Applicants' attorney Edmond A. DeFrank and Examiner Stevens and a supervisory Examiner on May 5, 2005. The Office Action of January 21, 2005, the cited references and the pending claims were discussed in general. A proposed amendment modifying the independent claims was discussed during the interview. No agreement was reached during the phone conversation.

The Final Office Action rejected claims 1-20 under 35 U.S.C. 112, first paragraph, as allegedly based on a disclosure that is not enabling.

In particular, the Examiner stated that the "white space determinations" as described in Fig. 3, element 310 and claimed "merely state that a determination is made." The Examiner continued by stating that "[C]ommon sense dictates that enablement requires an explanation of how Applicant makes such a determination, not merely a statement that such a determination is being made."

The Applicant respectfully traverses this rejection and the arguments made by the Examiner and submits that the rejection should be withdrawn because the Examiner has not provided a prima facie case of non-enablement. First, the Applicant requests case law authority for the Examiner's requirement that "[C]ommon sense dictates that enablement requires an explanation of how Applicant makes such a determination, not merely a statement that such a determination is being made." If the Examiner cannot provide case law to support this requirement, the Examiner cannot require it. **Ailnomoto Co., Inc. v. Archer-Daniels-Midland Co.**, 228 F3d 1338, 56 USPQ 1332, 1136 (Fed. Cir 2000), *cert. denied*, 532 U.S. 1019 (2001).

Second, contrary to the Examiner's requirement, it is well settled that in order for an Examiner to maintain a prima facie case of non-enablement, the Examiner must provide the following: a rational basis as to why the disclosure does not teach or why to doubt the objective truth of the statements in the disclosure that purport to

teach; the manner and process of making and using the invention that corresponds to the scope of the claims to one of ordinary skill in the art requires undue experimentation; and it deals with subject matter that would not already be known to the skilled person as of the filing date of the application. Since the Examiner cannot prove these elements, the rejection is not proper under Section 112, first paragraph. Merely stating a conclusion that "common sense dictates" is not enough for the Examiner to maintain a non-enablement rejection. Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362, 52 USPQ2d 1129 (Fed. Cir. 1999). In re Wright, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993).

In addition, the CCPA has stated that the "PTO has the burden of giving reasons, supported by the record as a whole, why the specification is not enabling... Showing that the disclosure entails undue experimentation is part of the PTO's initial burden..." In re Angstadt, 190 USPQ 214, 219 (C.C.P.A. 1976). Although the Examiner attempted to bypass this requirement by stating that "common sense dictates that enablement requires an explanation of how Applicant makes such a determination, not merely a statement that such a determination is being made", the Applicant submits that the Examiner is not permitted to do so.

Namely, the court in Stahelin v. Seher, 24 USPQ2d, 1513 (B.P.A.I. 1992) clearly stated that "[I]t has been consistently held that the first paragraph of 35 USC 112 required nothing more than objective enablement... How such a teaching is set forth, whether by use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims *must* be taken as complying with the first paragraph of 35 USC 112 *unless* there is a reason to doubt the objective truth of the statements relied upon there for enabling support. *Id.* At 1516 (citing In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (C.C.P.A. 1971)) (emphasis in original).

Further, the Fed. Circuit has clearly stated that patent applications are written for persons familiar with the relevant field; the patentee is not required to include in the specification specific programming code as long as the concept is readily understood by practitioners. Otherwise, every patent would be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Verve LLC v. Crane Cams Inc., 311 F.3d 1116, 65 USPQ 2d 1051, 1053-54 (Fed. Cir. 2002).

Publication No. 2003/0023631) with reference to Figs. 2-3 of the Applicant's disclosure (page 3, line 5 through page 4, line 3) is enabling with respect to the claims because it describes a typical web page with information content and determining unused available space on that page for placing the micro-advertisements in the unused available space.

Since the Examiner has not set forth a reasonable explanation as to why he believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement, the rejection must be withdrawn. As argued above, the Examiner cannot use his "common sense dictates" argument because it is not supported by the case law. Instead, the Examiner must give a detailed explanation, which he has not and cannot, supported by the record as a whole, why the specification is not enabling, including a showing that the disclosure entails **undue experimentation**. In re Wright, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993). In re Angstadt, 190 USPQ 214, 219 (C.C.P.A. 1976).

Examiners can only reasonably doubt an invention's asserted utility if the written description "suggests an inherently unbelievable undertaking or involves implausible scientific principles," which is clearly not the case here. In re Cortright, 49 USPQ 2d 1464, 1466 (Fed. Cir. 1999). Last, the court in Enzo Biochem, Inc. v. Calgene, Inc., 52 USPQ 2d 1129, 1135-36 (Fed. Cir. 1999) concluded that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, as long as the experimentation is not undue. As such, for the reasons as set forth above, the Applicant submits that the rejection should be withdrawn because the claims are enabling and comply with 35 U.S.C. 112, first paragraph.

Claims 1-11, 14-15 and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta et al. (U.S. Patent No. 6,487,538) in view of Bier (U.S. Patent Application No. 2002/0073125). Claims 12-13 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta et al. in view of Bier and further in view of a Laura Lemay publication (SAM'S Teach Yourself Web Publishing with HTML 4 in 21 Days, 2nd Edition, Sam's Publishing), hereinafter referred to as Lemay.

The Applicant respectfully traverses these rejections based on the amendments to the claims and the arguments below.

The Applicant's independent claims have been amended to include using software for automatically determining available unused space on the web page for the micro-advertisement, the available space not interfering with the information content, selecting the micro-advertisement, from a plurality of micro-advertisements, to place on the web page and automatically placing the micro-advertisement on the web page in the available unused space.

The Applicant submits that the Gupta reference, alone or in combination with the Bier reference do not disclose, teach, or suggest all of the claimed features of the amended claims. Although Gupta et al. disclose examining unused space and Bier discloses making white space editable, Gupta et al. in combination with Bier clearly do not disclose the Applicant's using software for automatically determining available unused space on the web page for the micro-advertisement and automatically placing the micro-advertisement on the web page in the available unused space.

Instead, Bier explicitly discloses manual intervention by preparing "...a set of user interfaces querying the user as to whether the items should be suppressed, whether the white space between items should be made editable by adding an HTML text area between items, and whether the template content should be suppressed" and not using software for automatically determining available unused space and automatically placing the micro-advertisement on the web page in the available unused space. In contrast, Bier discloses "...a user selecting one or more suppression and/or make editable techniques..." (*emphasis added*, see paragraph [0042] of Bier).

As such, since the cited references, when **combined**, are clearly missing at least one limitation of the Applicants' claimed invention, the combined references cannot be used to render the claims obvious. In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

With regard to the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

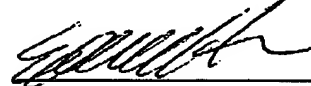
Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818)

Serial No.: 09/916,970
Attorney Docket No.: 10005874-1

885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

Respectfully submitted,
Dated: May 23, 2005



Edmond A. DeFrank,
Attorney for Applicants
Reg. No. 37,814
(818) 885-1575 TEL
(818) 885-5750 FAX